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09/248,595	02/11/99	FEENEY	B P-5761-SPALD

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EXAMINER
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 23

Application Number: 09/248,595
Filing Date: 02/11/1999
Appellant(s): Brian Feeney et al.

Diane F. Covello
For Appellant

EXAMINER'S ANSWER



UNITED STATES DEPARTMENT OF COMMERCE
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 23

This is in response to appellant's brief on appeal filed 09/24/2001.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

Appellant has indicated that there are no known appeals or interferences related to this application.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is adequate.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1, 2, 5, 6, 8, 9 and 12 as grouped on page 6, do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

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(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

4755187	<i>Friese et al.</i>	07/1988
5069935	<i>Walters</i>	12/1991

10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-6, 8-12, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Friese et al (4,755,187)** and **Walters (5,069,935)**.

Friese et al shows a method of waterproofing leather by “fatliquoring” agents which produces extremely soft leather and reduces permeability to water. Essentially the process is for the tanning of leather, comprising at least the steps of dyeing and/or tanning, retanning and fatliquoring, the improvement for imparting improved waterproof properties to the leather. Friese et al uses the “end product” for shoe upper leather, garment quality suede and heavy suede. However, Friese et al does not specifically teach that the aforementioned leather can also be used to make a football, but does not teach away from it.

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Walters shows a game ball with a tanned leather cover (26) that has moisture resistance properties; a lining (27) made from a sheet (28) of vinyl-impregnated polyester fabric containing two or three plies; and an inflatable bladder (34) made of butyl rubber or a synthetic material which is known in the art (Column 3, lines 38-52 and Column 4, line 24-27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the “fatliquored” leather of Friese et al to the football of Walters in order to provide a waterproofed leather football with improved water proofing qualities.

Regarding the preamble recitation that the ball is a “game ball” no patentable weight has been given to the term “game ball” because such is a functional and inferential term. Any ball can be used as a game ball. Regarding the recitation “wherein when said ball is subjected to three 90 minute cycles of a rain test, such ration being a maximum of 1.25:1.”, such is not given patentable weight because such is a mere “method of testing” the “end product” under various test conditions in order to determine its durability, i.e. 90 minutes cycles of a rain test, and is not considered to be structure. Indeed the claims never specify what specific structure of the leather on the ball results in this desirable intended use. It is a mere statement of any and all desirable qualities without providing any instruction as to the specific kind of leather or its structural attributes.

Regarding claim 2, the recitation of “wherein, said ratio is a maximum of 1.15:1” has been given no patentable weight since the ratio is a result of subjecting the “product” to specific test procedures and is not directed to a structural limitation in a structure claim.

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Regarding claims 5 and 6, Walters shows a vinyl-impregnated polyester fabric containing two or three plies. Although applicant has removed the “vinyl” limitation from the claim, still a “polyester” fabric is vinyl-impregnated, and it is well known to use a lining made from the groups consisting of epoxy, polyester and urethane materials, and such use here would have been obvious to one skilled in the art to gain the desired qualities.

Regarding the recitation in claim 3, “wherein when said ball is subjected to six 45 minute cycles of a rain test, at the conclusion of said six rain test cycles being a maximum of 1.19:1.” has been given no patentable weight since it is a “method of testing” the “end product” ” under various test conditions in order to determine its durability, i.e. 45 minute cycles of rain test, and it is not considered to be structure and is, as noted before an attempt to cover all possible leathers without claiming their features.

Regarding claim 4, the recitation of “wherein, said ratio is a maximum of 1.10:1” has been given no patentable weight since the ratio is a result of subjecting the “product” to specific test procedures.

Regarding the recitation in claim 8, the phrase “wherein when said ball is maximum 90 g of water at the conclusion of said sixth rain test cycle.” has been given no patentable weight since it is a “method of testing” the “end product” ” under various test conditions in order to determine its durability, i.e. six 45 minute cycles of rain test, and it is considered to be functional language rather than a structural limitation.

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Regarding claim 9, the recitation of “wherein, said ball will absorb maximum of 65g at the conclusion of said sixth rain test cycle.” has been given no patentable weight since the ratio is a result of subjecting the “product” to specific test procedures.

Regarding claim 10, the recitation of “wherein, said ball will absorb a maximum per cycle water gain of 115 g water test cycle.” has been given no patentable weight since the ratio is a result of subjecting the “product” to specific test procedures.

Regarding claim 11, Friese et al shows a method of waterproofing leather by “fatliquoring” agents which produces extremely soft leather and reduces permeability to water. Essentially the process is for the tanning of leather, comprising at least the steps of dyeing and or tanning, retanning and fatliquoring, the improvement for imparting waterproof properties to the leather.

Regarding the preamble recitation that the ball is a “game ball” no patentable weight is given to the term “game ball” because such is a functional and inferential term. Any ball can be used as a game ball, such as the one disclosed by Walters.

Regarding claim 12, the recitation of “wherein whenmaximum of 1.25:1.” has been given no patentable weight since the ratio is a result of subjecting the “product” to specific test procedures.

Regarding claim 17, the recitation of “wherein whenmaximum of 1.27:1 Conclusion of said first rain test cycle.” has been given no patentable weight since the ratio is a result of subjecting the “product” to specific test procedures.

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Regarding claim 18, the recitation of “wherein when maximum of 110 been given since the ratio is a result of subjecting the “product” to specific test procedures and is not structure.

(11) Response to Argument

1. In response to appellant’s argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, combining a method of producing a better waterproof leather with a known waterproof leather game ball in order to increase resistance to moisture absorption would have been obvious to one of skilled in this art with the references before him to gain the advantages of the better leather.

In response to Appellant's argument that the references fail to show certain features of applicant's invention, it is noted that the alleged features upon which applicant relies (i.e., game ball is placed in a test chamber and an oscillating water spray is disposed over the game ball) are not structure recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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In response to appellant's argument that by subjecting an existing leather to numerous cycles of "rain test", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Appellant is attempting to distinguish an apparatus claim by claiming a process of testing, wherein the specific structure that meets such test has neither been claimed nor disclosed.

In response to Appellant's arguments against the references individually, one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Appellant is not claiming the method of testing a game ball by placing a game ball in a test chamber and subjecting the game ball to an oscillating water spray. As pointed out above the claims are not directed to a method of testing a game ball. Furthermore, the process of subjecting a piece of leather or an assembled ball to water (whether sprinkled or submerged) is demonstrated by Carlson (3,708,333) and it is considered to be a well known method of determining the amount of water absorbed by a leather sample or a game ball.

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With respect to subjecting a game ball to various cycles of tests for various periods of time, such tests are considered obvious, since it would be at the tester's discretion to subject the game ball to any number of cycles and for the time period required, in order to achieve the results needed for the intended purpose.

With respect to the relevancy of the Walters and Friese et al's references, Walters clearly shows a game ball having a bladder a lining and a cover that has been subjected to various tests to see how well it holds up in real conditions. Friese et al shows a method for producing water proof leather. To use Friese et al's leather to make a game ball as it is shown by Walters and then subjecting the game ball to tests similar to the tests taught by either Carlson or Walters would have been obvious to one of skilled in this art with the references before him. As Appellant have clearly pointed out in their disclosure, any known leather can be taken and used to make an "improved" game ball.

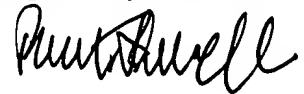
Appellant does not specify in the claims that the game ball can not be pre and post-assembly coated. In any event, in "pre-assembly" the tanned leather of Walters is coated, and this coating is considered to be a part of the tanning process.

In conclusion, if the game ball is superior because of the type of leather used in combination with the bladder and the lining, then Appellant should claim the specifics of the leather, the bladder and the lining. Appellant cannot argue that his waterproof ball is patentable over other waterproof balls because the specific leather has advantages without claiming the specific leather.

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For the above reasons, it is believed that the rejections should be sustained.

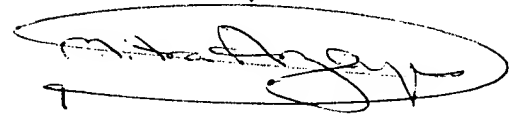
Respectfully submitted,



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October 30, 2001

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